

**Remarks**

The present application includes claims 1-4, 7-15, and 18-21. Claims 1-4, 6-15, and 17-21 have been rejected by the Examiner. By this Response, claims 1, 7, 12, and 18 have been amended. Claims 6 and 17 have been canceled and incorporated into independent claims 1 and 12, respectively.

**Claims 1 and 12 have been rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over IGT Beetle Bailey's Roll for Ranks Slot game (BBR4R).**

In addition to claims 1 and 12, the Examiner also references dependent claims 2, 3, 4, 10, 13, 14, and 15 with respect to BBR4R. Applicant respectfully traverses the Examiner's rejection for at least the following reasons.

By this response, the limitations recited in dependent claims 6 and 17 have been incorporated into their respective independent claims 1 and 12. While the Applicant respectfully disagrees with the Examiner's assertion that all of the limitations of independent claims 1 and 12 are found in or obvious over the disclosure of the BBR4R document, the Applicant has incorporated these additional limitations into the independent claims in order to expedite allowance of those claims. The Applicant reserves the right to pursue the unamended claims in a related application. The Applicant respectfully submits that the independent claims should be allowable over the cited art of record at least because the cited art fails to show that a probability of success of the outcome is determined by a game controller so that an average total prize awarded for the

feature, if the player continues with the feature, is approximately the same as the total prize the player would get if the player chose to leave the feature.

**Claims 6-9, 11, and 17-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over BBR4R and further in view of official notice.**

As discussed above, BBR4R fails to teach, motivate, or reasonably suggest the limitations recited in independent claims 1 and 12, into which the limitations of dependent claims 6 and 17 have been incorporated.

On page 4 of the present action, the Office Action asserts that “BBR4R discloses: should the player wish to continue playing the feature, a probability of success of the outcome is determined by the controller so that an average total prize awarded for the feature is approximately the same as the total prize the player would get if the player chose to leave the feature.” However, the Applicant has carefully reviewed the documents cited in the Office Action concerning BBR4R, and can find no disclosure of this feature.

The game description of BBR4R simply mentions the alternatives of ascending the ranks to receive a handsome reward or else receiving a consolation prize.

The Office Action further states that “the examiner takes official notice that the choice to pay more in one bonus and less in another is clearly a design choice and that the game would not be affected by these differences as admitted by the applicant in the effort of claiming three different embodiments for the bonuses in claims 6, 7 and 8.”

The Applicant notes that claims 6, 7 and 8 are not all at the same level in the hierarchy of claims. Instead, claim 8 is dependent on claim 7 which is in turn dependent

on claim 6. This is a standard claim structure in which claims of increasingly narrow scope are presented. It is respectfully submitted that there is no implication in this claim structure that the different claims merely representing different design choices.

The Applicant also notes that claims 7 and 8 define different features. Claim 7 defines a step of the controller determining the prize for a subsequent stage of the feature. In contrast, claim 8 defines a probability of success of the subsequent stage.

Claims 6, 7 and 8 do not constitute in any way an admission by the Applicant that the claimed features do not affect the game. Rather, the claimed features operate to determine the average payout of the game. This is clearly a matter of some commercial concern to an operator of the gaming machine and has a clear effect on the playing of the game.

In view of at least the foregoing comments, it is respectfully submitted that claims 1 and 12 are patentable in light of BBR4R. The remaining claims are dependent on these independent claims and are believed patentable over the cited art for at least the reasons given above. However, each dependent claim is deemed to define an additional aspect of the invention and individual reconsideration is respectfully requested.

It is submitted that the present application is in condition for allowance and a notice of allowability is respectfully solicited.

#### **Official Notice**

As previously stated, the Applicant disagrees with the Examiner's assertion of Official Notice in the context of these pending claims and in terms of whether variation in probabilities and bonus amounts is "clearly a design choice" in the context of the

pending claims. The limitations recited in the pending claims go well beyond an “obvious” design choice to determine bonus prize amounts.

Upon being awarded at least one prize in the feature, the player is offered a choice and, if the choice results in a successful outcome, the player has the option of continuing with the feature. If the choice results in an unsuccessful outcome, the feature ends and a portion, but not all, of the total prize accumulated up to termination of the feature is forfeited. The prize award is determined by a controller such that an average total prize awarded for the feature is approximately the same as the total prize to the player if the player chose to leave the feature rather than continue. The claims recite a particular configuration, a particular sequence of base game and feature, and a particular system/method for rewarding and entertaining a player that goes well beyond an “obvious” design choice to determine prize awards. The Applicant respectfully submits that the pending claims represent novel, useful and non-obvious improvements over the prior art of record and should be allowable. As discussed further below, if the Examiner is asserting that the particular system and methods claimed in the present application are either inherent or well known (i.e., taking official notice), then the Examiner is asked to provide further evidence to which the Applicant can respond. As it now stands, such evidence appears to be lacking.

The Applicant respectfully traverses the Examiner’s assertion for at least the reasons stated above and as further provided below.

If the Examiner’s assertions are based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner’s assertions must be supported by an affidavit from the Examiner. According to MPEP §

2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are “capable of instant and unquestionable demonstration as being well-known.” That is, the subjects asserted must be of “notorious character” under MPEP § 2144.03(A).

However, the Applicant respectfully submits that the subject matter of the Examiner’s assertion of Official Notice is not well-known in the art as evidenced by the searched and cited prior art. The Applicant respectfully submits that the Examiner has performed “a thorough search of the prior art,” as part of the Examiner’s obligation in examining the present application under MPEP § 904.02. Additionally, the Applicant respectfully submits that the Examiner’s searched and cited references found during the Examiner’s thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner’s thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the Examiner’s assertion of Official Notice. That is, the Examiner’s thorough and detailed search of the prior art has failed to yield any mention of the teachings that the Examiner is asserting as widely known in the art. The Applicant respectfully submits that if the subject matter of the Examiner’s assertion of Official Notice had been of “notorious character” and “capable of instant and unquestionable demonstration as being well-known” under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner’s thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicant respectfully submits that the prior art does

not teach the subject matter of the Examiner's assertion of Official Notice and respectfully traverses the Examiner's assertion of Official Notice.

As stated above, the Applicant respectfully traverses the Examiner's assertions of Official Notice and submits that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known." Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice. Additionally, the Applicant respectfully requests the Examiner reconsider the assertion of Official Notice and provide to Applicant any basis for the Examiner's assertion of Official Notice. The BBR4R game reference provides none of the teachings alleged as well known and necessary by the Examiner. Whereas games must have a payable, the recitation of particular probability calculations for success and for prize determination and use of the controller recited in the pending claims are not necessary in that form and are not well known in the art. Furthermore, the particular equations cited in claims 9 and 20, which add further limitations to claims 8 and 19, respectively, are neither well known nor necessary in all games. The Applicant respectfully submits that these limitations establish a new way of game play, determination of success, and awarding of a prize. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicant at the number below for further discussion.

Additionally, according to MPEP § 2112, an examiner must provide rationale or evidence tending to show inherency. The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result. *In re*

*Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Examiner has not provided why it necessarily flows from BBR4R that success probabilities and prize awards amounts are necessarily determined as outlined in the pending claims. Success and prize award determination may occur in a variety of ways. It does not necessarily flow from BBR4R that the probabilities and calculations occur in the ways recited in the pending claims using the components recited.

Thus, the Applicant respectfully traverses the Examiner’s assertions of Official Notice and/or inherency and submits that the claims should be allowable over the cited art.

**CONCLUSION**

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

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